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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,828	03/26/2004	Masayuki Morita	740250-890	7960
22204	7590	11/17/2004		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128				
EXAMINER STOCKTON, LAURA LYNNE				
ART UNIT		PAPER NUMBER		
1626				

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/809,828

Applicant(s)

MORITA ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/666,481.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/26/04 &amp; 7/9/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

Claims 1-6 are pending in the application.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/666,481, filed on September 20, 2000.

### *Information Disclosure Statement*

The Information Disclosure Statements filed on March 26, 2004 and July 9, 2004 have been considered by the Examiner.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-6, "isothiazoline-3-one" is misspelled. In claims 2 and 3, "The method" lacks antecedent basis from claim 1 since claim 1 is directed to "An industrial disinfectant composition". In claims 5 and 6, "The method" lacks antecedent basis from claim 4 since claim 4 is directed to "An industrial disinfectant composition".

### *Claim Rejections – 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- a) Lewis et al. {U.S. Pat. 3,849,430} – see Example 2 in column 5;
- b) Kim et al. {GB 2,308,364} – see the products of Reaction Scheme 5 on page 12;
- c) Bayer et al. {U.S. Pat. 5,420,290} - see, for instance, the compound in column 15, lines 49-50;
- d) Hahn et al. {U.S. Pat. 5,453,507} – see, for instance, Example 19 in column 9;
- e) Yen et al. {U.S. Pat. 5,290,512} – see Example II in column 3;
- f) Jordan {DE 3702546} – see, for example, the first compound on page 4, lines 1-9; or
- g) Lewis et al. {U.S. Pat. 3,523,121} – see, for instance, Example 45 in columns 7 and 8.

Each of the above cited prior art disclose at least one product that is embraced by the instant claimed invention.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. {U.S. Pat. 3,849,430}, Bayer et al. {U.S. Pat. 5,420,290}, Hahn et al. {U.S. Pat. 5,453,507}, Yen et al. {U.S. Pat. 5,290,512}, Lewis et al. {U.S. Pat. 3,523,121} and Jordan {DE 3702546}, each taken alone and in combination with each other when similar utilities are asserted.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim 2-alkyl-4-isothiazoline-3-one products. Lewis et al. (column 1, lines 14-54; column 3, lines 61-75; column 4, lines 6-18; Table I in column 5; and especially Example 2 in column 5), Bayer et al. (column 1, lines 19-52; and especially the compound in column 15, lines 49-50), Hahn et al. (column 1, lines 11-27; and Example 19 in column 9), Yen et al. (column 2; and especially Example II in column 3), Lewis et al. (column 1; column 9, lines 65-75; and especially Example 45 in columns 7 and 8) and Jordan (page 2; and especially the first compound on page 4, lines 1-9) each teach 2-alkyl-4-isothiazoline-3-one products that are either structurally the same as (see above 102 rejections) or structurally similar to the instant claimed compounds.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between some of the products of the prior art and the products instantly claimed is that the instant claimed products are generically taught in the prior art.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed products derives from the expectation that structurally similar products would possess similar activity (e.g., a disinfectant).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as a disinfectant. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from

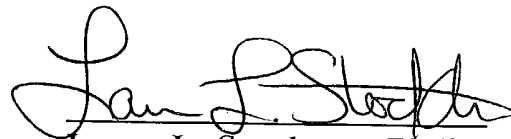


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either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

November 15, 2004